UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,859	04/27/2005	Carlos Portasany Sanchez	P/189-362	4887

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EXAMINER
KARIKARI, KWASI

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 November 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-15</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-15</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been

withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/07/2008 and

11/05/2008 has been entered.

Response to Arguments

2.   Applicant's arguments with respect to claims 1-15 have been considered but are

moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section

102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the

invention was made.

    The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for
establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Nachef (U.S. 20020137545 A1), (hereinafter Nachef) in view of Nachef et al. (U.S.
20050207562 A1), (hereinafter Nachef II).**

Regarding claims 1 and 9, Nachef discloses a method/mobile telephone device

(= mobile equipment 1, see, [0127-29] Fig. 1 and 2), comprising:

an integrated circuit card with a subscriber identity module or a universal

subscriber identity module (= Sim smart card, see, Fig. 2), said card comprising a

storage operable for storing at least one application (= smart card stores data,

algorithms and Sim Toolkit applications, see [0005, 0015, 0023 and 0033-37]);

a device operable for remote access management of the card based on remote

access message reception by mobile telephony (= Sim Toolkit applications

communicates with applications installed in servers via short message channel,

see [0008 and 0023]);

at least one data array manager module for managing data arrays of at least one

application stored in the card, said at least one data array manager module

(= programmable interface with application; and creation of SIM Toolkit application from

applets, see [0100 and 0107-08]) comprising:

a receiver operable to receive, by means of a remote access message received

by mobile telephony, at least one instruction for operating on at least one piece of data

contained in an array of a specified application (= master application 30M sends

proactive command included in short message to be executed by circuit 10 via slave Sim Toolkit application 22, see [0082, 0100-01 and 0124]);

an analyzer operable for analyzing said at least one instruction (= application 22 analyzes the data, see [0083]).

Although Nachef teaches modification of applications of SIM Toolkit (see [0171-72]); Nachef fails to mention "an accessing device operable for accessing said array, said accessing device further comprising a receiver operable for receiving from the specified application a requested reference for said array; the accessing device being operable for accessing said array based on said reference; and apparatus operable for performing at least one operation on said at least one piece of data in said array, according to said at least one instruction, without the necessity of deleting and rewriting the entire specified application stored in the card".

However, Nachef II teaches that application management between cards 2 and 3 and card 2 can perform administration operations such as **addition 201, modification 203** and accessing and **installing commands** applets on card 3; followed by an interactive display on the screen; and proactive command (see [0006,0041-44; 0072-75 0080-0114 and Fig. 1, item 3]); whereby the modification and installing reads on "without the necessity of deleting and rewriting **the entire** specified application stored in the card".

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef II into the system of Nachef for the benefit of achieving

a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding claims 2 and 10, as recited in claims 1 and 9, Nachef fails to disclose "operable for asking the specified application for said reference of said array.

However, Nachef II teaches operable for asking the specified application for said reference of said array (= deletion and modification operation on data or applets present in the Sim card, see Abstract and [0006,0041-44; 0072-75 0080-0114).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef II into the system of Nachef for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding claim 3, as recited in claim 1,Nachef discloses that said specified application is a SIM Application Toolkit or a Universal SIM Application Toolkit application (=Toolkit applications, see [0023 and 0041-47]).

Regarding claim 4, as recited in claim 1, Nachef discloses the device, wherein said data array manager module is configured to be able to access arrays of a plurality of said applications (= API are programmable interfaces with applications, see [0083, 0105 and 0107-08]).

Regarding claim 5, as recited in claim 1, Nachef further discloses the device, wherein said data array manager module is part of said specific application having said data array to be accessed by said data array manager module (= API are programmable interfaces with applications, see [0083, 0105 and 0107-08]).

Regarding claim 6, as recited in claim 5, Nachef further discloses the device, wherein said data array manager module is an Application Programming interface (= API are programmable interfaces with applications, see [0083, 0105 and 0107-08]).

Regarding claim 7, as recited in claim 1, Nachef further discloses the device, wherein said device operable for remote access management is based on a GSM 03.48 standard or on a 3GPP 23.048 standard (see [0097 and 0120]).

Regarding claim 8, as recited in claim 3, Nachef further discloses that the device comprising a terminal supporting said Subscribe Identity Module (SIM) Application Toolkit or said Universal SIM Application Toolkit and also at least one of a supporting Data Download, and a class "e" terminal supporting the SIM Toolkit commands for channel management (see [0127-32]).

Regarding claim 11, as recited in claim 9, Nachef further discloses receiving said message in a terminal of subscriber equipment; sending said message from said terminal to the card; forwarding the at least one instruction via a remote access

manager module in the card to a data array manager module identified in the message
(see [0082-83 and 0107-08]).

Regarding claim 12, as recited in claim 11, Nachef further discloses that the message
is of the Data Download type (see [0127-32]).

Regarding claim 13, as recited in claim 12, Nachef discloses sending of said message
to the card by an ENVELOPE command (see [0068]).

Regarding claim 14, as recited in claim 11, Nachef discloses the method wherein the
message is sent to the card through a Bearer Independent Protocol-based channel
(= short message is use a transport technology, see [0023 and 0110]).

Regarding claim 15, as recited in claim 13, Nachef further discloses the method,
wherein the at least one instruction is forwarded to a data array manager module
identified by a Toolkit Application Reference field of the message (see Par. [0063]).

                                    CONCLUSION

   Examiner's Note: Examiner has cited particular columns and line numbers in the
references applied to the claims above for the convenience of the applicant. Although
the specified citations are representative of the teachings of the art and are applied to
specific limitations within the individual claim, other passages and figures may apply as
well. It is respectfully requested from the applicant in preparing responses, to fully

consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. SEE MPEP 2141.02 [R-5]   VI. PRIOR ART MUST BE CONSIDERED IN ITS ENTIRETY, INCLUDING DISCLOSURES THAT TEACH AWAY FROM THE CLAIMS: A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). >See also MPEP §2123.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-T (9am - 7pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571-272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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